



01 MAR 2007

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In re Application of: JUNG, Grace, et al. :
Application No.: 10/555,364 :
PCT No.: PCT/US2003/034655 : COMMUNICATION
Int. Filing: 31 October 2003 :
Priority Date Claimed: 02 May 2003 :
Attorney Docket No.: 48012.411USPC :
For: AMINOCYCLOHEXYL ETHER :
COMPOUNDS AND USES THEREOF :

This application is before the Office Of PCT Legal Administration for issues arising under 35 U.S.C. 371.

BACKGROUND

On 31 October 2003, applicants filed international application PCT/US2003/034655. The application claims a priority date of 02 May 2003, and it designated the United States. The deadline for payment of the basic national fee was thirty months from the priority date, i.e., 02 November 2005.

The published international application named nine applicant/inventors for the U.S: Gregory N. BEATCH, Lewis Siu Leung CHOI, Grace JUNG, Yuzhong LIU, Bertrand PLOUVIER, Richard WALL, Jeff ZHU, Alexander ZOLOTOTY, and Anthony G.M. BARRETT. In addition, the U.S. application file for the international application includes a "Notification Of The Recording Of A Change" (Form PCT/IB/306) mailed 07 November 2005 by the International Bureau (IB) indicating that a tenth applicant/inventor, Tao SHENG, has been added to the application, and the IB has also indicated that two additional inventors, Michael J.A. WALKER and Sandro L. YONG, were also added to the application during the international phase. Thus, the present application contains twelve applicant/inventors of record.

On 02 November 2003, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and an Application Data Sheet (ADS). The ADS identified only eight applicants. Seven of the listed inventors had previously been identified as inventors of record herein (BARRETT, CHOI, JUNG, PLOUVIER, LIU, ZHU, and SHENG); however, the ADS included an additional inventor, Doug Ta Hung CHOU, who had not been previously identified, and it failed to include five of the inventors of record (BEATCH, WALL, ZOLOTOTY, WALKER, and YONG).

On 16 August 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and sequence listing materials.

On 16 October 2006, applicants filed a response to the Notification Of Missing Requirements that included an executed declaration, a supplemental ADS, and a statement that the requested sequence listing materials were not required because the present application did not include any sequences. The revised ADS identified the same eight inventors as the original ADS, although the order of the inventors had been changed. The declaration was executed by the eight inventors listed on the ADS (JUNG, PLOUVIER, LIU, ZHU, SHENG, BARRETT, CHOI, and CHOU).

On 01 December 2006, the DO/EO/US mailed a "Notification Of Defective Response" (Form PCT/DO/EO/916) indicating that sequence listing materials were still required.

On 11 December 2006, the DO/EO/US mailed a "Withdrawal Of Previously Sent Notice" withdrawing the Form PCT/DO/EO/916 mailed 01 December 2006, and a "Notification of Acceptance (Form PCT/DO/EO/903) that identified 16 October 2006 as the date of completion of the requirements under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4).

Also on 11 December 2006, the USPTO issued a filing receipt identifying 16 October 2006 as 35 U.S.C. 371(c) date. The filing receipt also identified the eight inventors listed on the declaration as the applicants herein.

DISCUSSION

As noted above, the declaration includes an inventor, Dough Ta Hung CHOU, who is not of record in international application PCT/US2003/034655, and it does not include five inventors who are of record (Gregory N. BEATCH, Richard WALL, Alexander ZOLOTTOY, Michael J.A. WALKER and Sandro L. YONG). The inventive entity listed on the declaration filed by applicants on 16 October 2006 therefore does not correspond to the inventors of record in the international application.

Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
- (4) any new oath or declaration required by paragraph (f) of this subsection.

Applicants here have not submitted a request to correct inventorship under 37 CFR 1.497(d) to correct the inventorship of record to correspond to that listed on the declaration filed 16 October 2006. Accordingly, the declaration is unacceptable under 37 CFR 1.497 for failure to properly identify the inventors of record herein.

The Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt mailed 11 December 2006, based as they were on applicants' purported submission of an acceptable declaration under 37 CFR 1.497, are appropriately vacated.

CONCLUSION

The Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt mailed 11 December 2006 are hereby **VACATED**.

The declaration filed 16 October 2006 is defective for failure to identify, and be executed by, the proper inventors of record herein.

Applicant has **ONE (1) MONTH** from the mail date of the present communication to file a proper response.

A proper response must include either an oath or declaration acceptable under 37 CFR 1.497 or a grantable request under 37 CFR 1.497(d) to correct the inventorship of record to correspond to that listed on the declaration filed 16 October 2006.

Failure to file a proper and timely response will result in abandonment of the application.

Extensions of time are NOT available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration

A handwritten signature in black ink, appearing to read 'RM Ross', with a stylized flourish at the end.

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